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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,039	08/09/2000	Jamey Graham	15358-004240US	5597
20350	7590	02/18/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			CAMPBELL, JOSHUA D	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/636,039

Applicant(s)

GRAHAM ET AL.

Examiner

Joshua D Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-21 and 23-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-21 and 23-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/10 and 12/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 07/15/2004 and IDS filed on 07/15/2004 and 07/19/2004.
2. Claims 1-2, 4-21, and 23-41 are pending in this case. Claims 1, 11, 19, 20, 30, and 38-41 are independent claims. Claims 3 and 22 have been cancelled and claims 1, 11, 12, 14, 16-20, 30, 31, 33, and 35-41 have been amended.
3. The rejection of claims 11-13, 17-18, 30-32, and 36-37 under 35 U.S.C. 102(b) as being anticipated Rowe et al. has been withdrawn in view of amendments.
4. The rejection of claims 14-15, 19, 33-34, 38, and 40-41 under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. in view of Nielsen has been withdrawn in view of amendments.
5. The rejection of claims 16 and 35 under 35 U.S.C. 103(a) as being unpatentable over Rowe et al. in view of Nielsen further in view of Okamoto et al. has been withdrawn in view of amendments.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 20, ~~28~~ and 39 remain rejected under 35 U.S.C. 102(e) as being anticipated by Nielsen (US Patent Number 6,339,437, filed on September 30, 1997).

In regard to independent claim 1, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed (column 1, line 17-column 2, line 16 of Nielsen).

In regard to independent claim 20, the claim incorporates substantially similar subject matter as claim 1. Thus, the claim is rejected along the same rationale as claim 1.

In regard to independent claim 39, the claim incorporates substantially similar subject matter as claim 1. Thus the claim is rejected along the same rationale.

8. Claims 11 and 30 are rejected under 35 U.S.C. 102(a) as being anticipated by Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999).

In regard to independent claim 11, Acrobat discloses a method in which a document is accessed and a section of that document is shown in a first area and thumbnails of the document are displayed in a second area (Page 1-3 of Acrobat). Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4, items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being viewed).

In regard to independent claim 30, the claim incorporates substantially similar subject matter as claim 11. Thus, the claim is rejected along the same rationale as claim 11.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 2, 5, 21, and 24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) as applied to claims 1 and 20 above, and further in view of Gounares et al. (hereinafter Gounares, US Patent Number 6,681,370, filed on May 19, 1999).

In regard to dependent claims 2 and 21, Nielsen does not disclose a method in which the searching and marking of the document is performed using a Document Object Model configured by Internet Explorer. However, Gounares discloses a method in which a document that is converted into a Document Object Model tree using a web browser (i.e. Internet Explorer) to make changes to specific locations in a document by finding the location (searching) and editing the location (marking) (column 2, line 63-column 4, line 27 of Gounares). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching a document of Nielsen with the method of using a DOM tree to edit a document of Gounares because it would have provided a set standard of modeling, interfacing and manipulating the documents that are being marked.

In regard to dependent claims 5 and 24, Nielsen does not disclose a method in which the searching and marking of the document is performed using IMarkupServices interface configured by Internet Explorer. However, Gounares discloses a method in which a document that is converted into a Document Object Model tree using a web browser (i.e. Internet Explorer) to make changes to specific locations in a document by finding the location (searching) and editing the location (marking) (column 2, line 63-column 4, line 27 of Gounares). Gounares also discloses that IMarkupServices interface is used to insert tags into the document to edit the appearance (mark) (column 10, lines 8-59 of Gounares). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching a document of Nielsen with the method of using a DOM tree with IMarkupServices to edit a document of Gounares because it would have provided a set standard of modeling, interfacing and manipulating the documents that are being marked.

12. Claims 4 and 23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) as applied to claims 1 and 20 above, and further in view of msdn online Web Workshop (published online on April 20, 2000).

In regard to dependent claims 4 and 23, Nielsen does not disclose a method in which IHTMLTxtRange Interface is used to perform the searching and marking of a document. However, msdn Online Web Workshop discloses that the IHTMLTxtRange interface is used to retrieve and modify text in an element, locate specific strings in the

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text, and carry out commands that affect the appearance of the text (i.e. search and mark) (Remarks Section of msdn Online Web Workshop). It would have been obvious to one of ordinary skill in the art to combine the method of searching of Nielsen with the method of searching and marking disclosed by msdn Online Web Workshop because it would have allowed for a simple interface to search and modify both plain text and HTML.

13. Claims 6-8 and 25-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) as applied to claims 1 and 20 above, and further in view of Okamoto et al. (hereinafter Okamoto, US Patent Application Publication Number 2002/0065814, US Filing date June 30, 1999).

In regard to dependent claims 6-8, Nielsen does not disclose a method in which tags are inserted into the document surrounded relevant text that identify what query the tag is in response to, by both tag id and color/style of the highlight that is set to correspond to each specific query. However, Okamoto discloses a method in which tags are inserted into the document surrounded relevant text that identify what query the tag is in response to, by both tag id and color/style of the highlight that is set to correspond to each specific query (page 11, paragraph 0245-0255 of Okamoto). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Nielsen with the method of searching a document by Okamoto because it would have provided a user with a

simple way to search and customize the identification of terms when viewing a document.

In regard to dependent claims 25-27, the claims incorporate substantially similar subject matter as claims 6-8. Thus, the claims are rejected along the same rationale as claims 6-8.

14. Claims 9-10 and 28-29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) as applied to claims 1 and 20 above, and further in view of Schultz (US Patent Number 5,721,902, issued on February 24, 1998).

In regard to dependent claims 9 and 10, Nielsen does not disclose a method in which scores are calculated for the concepts in a document based on a frequency of text patterns that are relevant to the specific concepts. Nielsen also does not disclose a method in which a relevance indicator is displayed based on relevance score calculations. However, Schultz discloses a method in which relevance scores are determined based on the frequency that the query terms appear in a document (column 25, line 5-column 26, line 20 of Schultz). Schultz also discloses that a graphical representation providing the results or the relevance scoring is provided to the user (column 25, line 5-column 26, line 20 of Schultz). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching by Nielsen with the method of ranking relevance of a document based on

search terms by Schultz because it would have provided a user with a visual representation of the relevance of a document to the query terms.

In regard to dependent claims 28 and 29, the claims incorporate substantially similar subject matter as claims 9 and 10. Thus, the claims are rejected along the same rationale as claims 9 and 10.

15. Claims 12, 13, 17, 18, 31, 32, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999).

In regard to dependent claim 12, Acrobat discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat).

In regard to dependent claim 13, Acrobat discloses a method in which the thumbnail sizes can be changed to a different reduction level (reduction ratio) and the content still correctly corresponds to the original document (Page 1 and 5, items 1 and 5 of Acrobat).

In regard to dependent claim 17, Acrobat discloses a method in which determining information about a document (coordinates and dimension) for creating thumbnail representations of the document incorporate all formatting of that document (Pages 1-5 of Acrobat).

In regard to dependent claim 18, Acrobat discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (Pages 1-5 of Acrobat).

In regard to dependent claims 31-32 and 36-37, the claims incorporate substantially similar subject matter as claims 12-13 and 17-18. Thus, the claims are rejected along the same rationale as claims 12-13 and 17-18.

16. Claims 14-15, 19, 33-34, 38, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) as applied to claims 11 and 30 above, and further in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997).

In regard to dependent claim 14, Acrobat discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (Pages 1-5 of Acrobat). Acrobat does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16

of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Nielsen because it would have provided a user with a simple way to search and identify terms when viewing a document.

In regard to dependent claim 15, Acrobat discloses a method in which the thumbnail representations of the document incorporate all formatting of that document which would include highlighted text entities (Pages 1-5 of Acrobat).

In regard to independent claim 19, Acrobat discloses a method in which a document is accessed and a section of that document is shown in a first area and thumbnails of the document are displayed in a second area (Page 1-3 of Acrobat). Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4, items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being viewed). Acrobat does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality of concepts. However, Nielsen

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discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Nielsen because it would have provided a user with a simple way to search and identify terms when viewing a document.

In regard to dependent claims 33-34, the claims incorporate substantially similar subject matter as claims 14-15. Thus, the claims are rejected along the same rationale as claims 14-15.

In regard to independent claims 38 and 40-41, the claims incorporate substantially similar subject matter as claim 19. Thus, the claims are rejected along the same rationale as claim 19.

17. Claims 16 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) further in

view of Okamoto et al. (hereinafter Okamoto, US Patent Application Publication Number 2002/0065814, US Filing date June 30, 1999).

In regard to dependent claim 16, neither Acrobat nor Nielsen disclose a method in which the style information relevant to a concept is modified and in response all entities that correspond to that concept are changed to correspond with the new style information. However, Okamoto discloses a method in which a concept tag number, which corresponds to one of a plurality of concepts, is directly associated with a specific style (page 12, paragraph 0270-0276 of Okamoto). When that style information is changed all tags corresponding to the tag number associated with that style information will reflect that change (page 12, paragraph 0270-0276 of Okamoto). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Okamoto because it would have provided a user with a simple way to search and customize the identification of terms when viewing a document.

In regard to dependent claim 35, the claim incorporates substantially similar subject matter as claim 16. Thus, the claim is rejected along the same rationale as claim 16.

Response to Arguments

18. Applicant's arguments with respect to claims 11-19, 30-38, and 40-41 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to claims 1,2, 4-10, 19-21, 23-29, 38, 39, and 41, have been considered but are not persuasive. As shown in the rejection above, Nielsen discloses a method in which information (a query) is received identifying a set of one or more concepts (query terms); a set of text patterns comprising one or more text patterns (the query term or terms themselves) associated with the one or more concepts in the set a concepts, wherein the plurality (defined as one or more by the claim itself) of text patterns (the query term itself) are determined for a least one concept (query term) in the set of concepts. Thus, in the claims current form it does not overcome the rejection by the Nielsen reference as stated.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

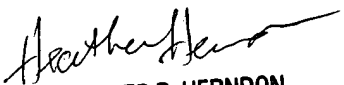
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC

February 11, 2005


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